

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MINNESOTA**

MICHAEL JAMES OTTO,

Plaintiff,

v.

INDEPENDENT SCHOOL DISTRICT NO. 273,
a.k.a. EDINA SCHOOL DISTRICT,

Defendant.

Case No.: _____

COMPLAINT

JURY TRIAL DEMANDED

Plaintiff Michael James Otto, by and through counsel, states and alleges the following against defendant Independent School District No. 273:

THE PARTIES

1. Michael James Otto (“Otto”) is an individual residing at 300 4th Street South, Grove City, MN 56243.

2. Independent School District No. 273 (“ISD 273”) is a local government entity organized under the laws of the State of Minnesota with its principal place of business at 5701 Normandale Road, Edina, MN 55424.

JURISDICTION AND VENUE

3. This is an action for copyright infringement in violation of the Copyright Act of 1976 (17 U.S.C. §§ 101 et seq.). This Court has federal question jurisdiction over this case pursuant to 28 U.S.C. §§ 1331 and 1338. This Court has supplemental jurisdiction over the state law claims under 28 U.S.C. § 1367.

4. This Court has personal jurisdiction over ISD 273 because it is organized under the laws of the State of Minnesota; has its principal place of business in this district; and has committed numerous acts of copyright infringement at issue within this district.

5. Venue in this district is proper pursuant to 28 U.S.C. §§ 1391(b) & (c) and § 1400(a).

FACTUAL BACKGROUND

Otto's Work & Copyright

6. Otto is the sole author and owner of U.S. Copyright Registration No. VA 109-783 for a design for a hornet ("the Hornet Logo" or "Otto's Hornet Logo"). A true and correct copy of U.S. Copyright Registration No. VA 109-783 is attached as **Exhibit A**.

7. Otto's copyright registration represents *prima facie* evidence of the validity of his copyright and the facts stated in the certificate, including but not limited to ownership.

Otto & ISD 273 Contract

8. On August 5, 1981, ISD 273 entered into a written agreement with Otto that allowed the ISD's Athletic Department to use the Hornet Logo but requiring written permission by Otto for any use (the "Hornet Logo Contract"). A true and correct copy of the Hornet Logo Contract is attached as **Exhibit B**.

9. Since 1981 the usual means of obtaining permission under the Hornet Logo Contract was for ISD 273 to contact Otto and receive permission from Otto before any new use of the Hornet Logo. This practice constituted the normal course of conduct under the Hornet Logo Contract.

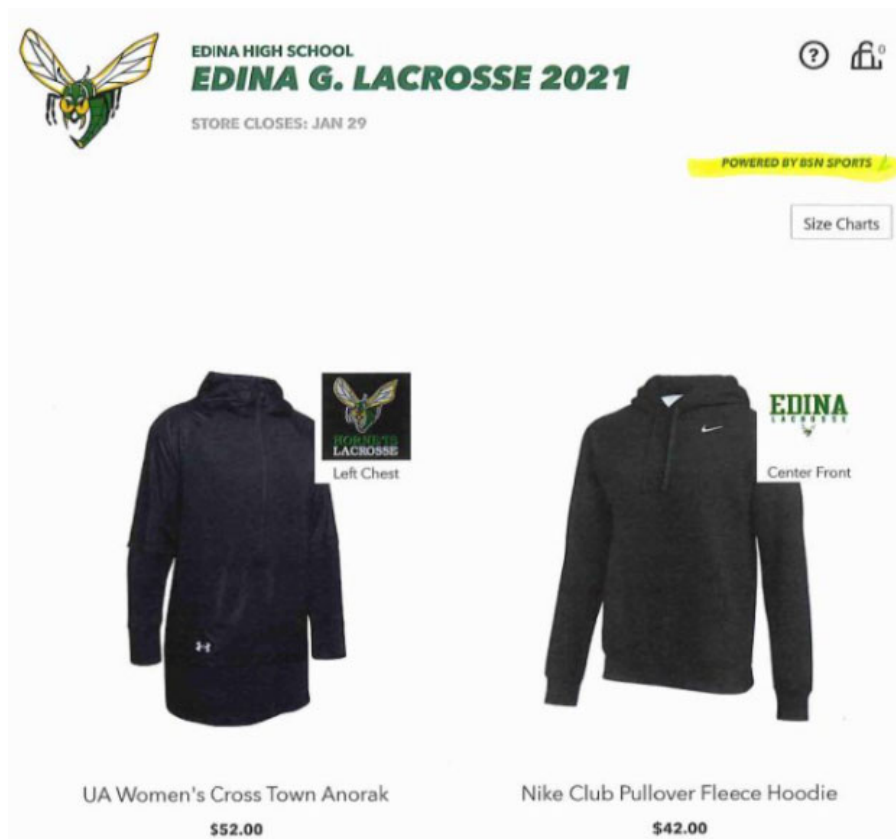
10. For approximately 37 years, ISD 273 contacted Otto before a proposed new use of the Hornet Logo and received Otto's permission to use the Hornet Logo. Otto never refused permission to an ISD 273 request to use the Hornet Logo during this time.

11. However, beginning with the 2019-2020 school year, ISD 273 began using the Hornet Logo without Otto's permission and continues to do so today.

12. During the 2019-2020 school year, ISD 273 began authorizing third parties to use the Hornet Logo without Otto's permission, and ISD 273 continues to do so today.

13. Examples of unauthorized third-party use is shown below:





14. Since the 2019-2020 school year, Otto repeatedly notified ISD 273 that it was in breach of the Hornet Logo Contract and infringing his copyright in the Hornet Logo.

15. On March 4, 2021, Otto informed ISD 273 that he was terminating the Hornet Logo Contract effective at the end of the 2020-21 school year. Attached as **Exhibit C** and hereby incorporated by reference is a copy of the letter notifying ISD 273 of the termination.

16. To date, ISD 273 continues its unauthorized use of the Hornet Logo.

COUNT I **INFRINGEMENT OF REGISTERED COPYRIGHT**

17. Otto restates and hereby incorporates by reference the allegations from the preceding paragraphs as if fully set forth herein.

18. Otto's Hornet Logo design for the registered copyright entitled "Edina High School hornet logo" is original work and constitutes copyrightable subject matter under the Copyright Act of 1976, 17 U.S.C. § 102.

19. Otto is the owner of the copyrightable subject matter in the registered copyright entitled "Edina High School hornet logo."

20. The United States Copyright Office issued to Otto a United States copyright registration for the work entitled "Edina High School hornet logo" as Certificate of Registration No. VA 109-783 (hereinafter, "Registered Copyright").

21. ISD 273 has used, copied, had copied, made a derivative, or had a derivative made of Otto's Hornet Logo on a variety of goods without authorization, permission, or license.

22. ISD 273's use and unauthorized reproduction of the design in Otto's Registered Copyright violates Otto's rights under 17 U.S.C. § 106 as the owner of the Registered Copyright.

23. As a result of the actions alleged above, Otto is entitled to an injunction, pursuant to 17 U.S.C. § 502, restraining ISD 273 its subsidiaries, officers, agents, employees, assigns, and all other persons acting in concert with them from engaging in any further acts of infringement in violation of the copyright laws.

24. Pursuant to 17 U.S.C. § 504(a), Otto is further entitled to recover from ISD 273 either actual damages that Otto has sustained and will sustain, as well as any gains, profits, and advantages acquired by ISD 273 as a result of its acts of copyright infringement, as set forth in 17 U.S.C. § 504(b); or statutory damages as provided by 17 U.S.C. § 504(c)(1).

25. Any further infringements by ISD 273 will be willful and because of the willfulness of ISD 273, Otto would be entitled pursuant to 17 U.S.C. § 504(c)(2) to recover

enhanced damages of up to \$150,000 per infringement, if Otto elects to seek statutory damages at the time of trial.

26. Pursuant to 17 U.S.C. § 505, Otto may recover his full costs and reasonable attorney's fees because of the infringement by ISD 273.

COUNT II
INDUCEMENT OF COPYRIGHT INFRINGEMENT

27. Otto restates and hereby incorporates by reference the allegations from the preceding paragraphs 1-16 as if fully set forth herein.

28. Upon information and belief, third parties have used, copied, had copied, made a derivative, or had a derivative made of Otto's Hornet Logo on a variety of goods without authorization, permission, or license.

29. Upon information and belief, ISD 273 intentionally took active steps to encourage and promote third parties' infringement of Otto's Hornet Logo.

30. As a result, pursuant to 17 U.S.C. § 501, ISD 273 has induced the infringement of Otto's Registered Copyright in violation of the Copyright Act of 1976.

31. Pursuant to 17 U.S.C. § 502, Otto is further entitled to injunctive relief restraining and enjoining ISD 273, its franchisees, officers, employees, agents, and all other persons acting on their behalf or in participation with them from engaging in any further inducement of infringement of Otto's Registered Copyright.

32. Pursuant to 17 U.S.C. § 504(a), Otto is further entitled to recover from ISD 273 either actual damages that Otto has sustained and will sustain, as well as any gains, profits, and advantages acquired by ISD 273 or third parties as a result of copyright infringement by third parties, as set forth in 17 U.S.C. § 504(b); or statutory damages as provided by 17 U.S.C. § 504(c)(1).

33. Any further infringements by third parties induced by ISD 273 will be willful and because of the willfulness, Otto would be entitled pursuant to 17 U.S.C. § 504(c)(2) to recover enhanced damages of up to \$150,000 per infringement by third parties induced by ISD 273 if Otto elects to seek statutory damages at the time of trial.

34. Pursuant to 17 U.S.C. § 505, Otto may recover his full costs and reasonable attorney's fees because of the infringement ISD 273 has induced by third parties.

COUNT III
BREACH OF CONTRACT

35. Otto restates and hereby incorporates by reference the allegations from the preceding paragraphs 1-16 as if fully set forth herein.

36. Otto and ISD 273 are parties to the Hornet Logo Contract attached as **Exhibit B**.

37. The conduct of Otto and ISD 273 since 1981 constitutes a course of conduct under the Hornet Logo Contract.

38. ISD 273 breached and continues to be in breach of the Hornet Logo Contract by its unauthorized use of the Edina Hornet Logo and its inducement of third parties to infringe Otto's Registered Copyright.

39. As a result of ISD 273's breaches of the Hornet Logo Contract, Otto has suffered damages in excess of \$75,000.

COUNT IV
UNJUST ENRICHMENT

40. Otto restates and hereby incorporates by reference the allegations from the preceding paragraphs 1-16 as if fully set forth herein.

41. ISD 273 has knowingly benefitted from unjust enrichment by use of the Edina Hornet Logo.

42. Otto conferred the benefit of the Edina Hornet Logo to ISD 273 through the Hornet Logo Contract attached as **Exhibit B** which granted exclusive and promissory use of the Edina Hornet Logo to ISD 273 for select purposes without the requirement of payment rendered to Otto in exchange.

43. The retention of the benefit to ISD 273 under the Hornet Logo Contract is inequitable to Otto under the circumstances as ISD 273 has continued to violate the contract through unauthorized third-party use of the Edina Hornet Logo.

44. ISD 273 is morally wrong for retaining the benefit of the Edina Hornet Logo due to their actions of copyright infringement and breach of contract which were inequitable to Otto.

45. As a result, Otto is entitled to all available appropriate remedies available.

JURY DEMAND

Pursuant to Federal Rule of Civil Procedure 38(b), Otto demands a jury trial for all issues so triable.

PRAYER FOR RELIEF

WHEREFORE, Otto respectfully requests this Court to grant the following relief:

- a. An order granting judgment in favor of Otto and against ISD 273 on all of Otto's claims;
- b. An order pursuant to 17 U.S.C. § 502 permanently enjoining ISD 273, its officers, subsidiaries, partners, employees, attorneys, and all others in active concert or participation with them, from directly or indirectly infringing Otto's Registered Copyright;
- c. An order pursuant to 17 U.S.C. § 503(a) impounding all ISD 273's unauthorized copies or derivatives of Otto's copyrighted Hornet Logo found within the United States;

d. An order pursuant to 17 U.S.C. § 503(b) that all ISD 273's unauthorized copies or derivatives Otto's copyrighted Hornet Logo found within the United States be destroyed, along with all other articles by means of which such copies or derivatives may be produced;

e. An award to Otto of statutory damages pursuant to 17 U.S.C. §§ 504(a)(2) and 504(c)(1);

f. A determination that ISD 273 has willfully infringed the Registered Copyright owned by Otto, and that Otto is entitled to an increased award of damages pursuant to 17 U.S.C. § 504(c)(2);

g. Alternatively, Otto may seek an award pursuant to 17 U.S.C. § 504(a)(1) and 504(b) of all damages suffered by Otto as a result of the infringement and of any profits of ISD 273 attributable to the infringement that are not taken into account in computing actual damages, in an amount to be determined at trial;

h. An award to Otto of its reasonable attorney's fees and costs pursuant to 17 U.S.C. § 505;

i. An award of damages sufficient adequate to compensate Otto for ISD 273's breaches of the Hornet Logo Contract;

j. An award to Otto of attorney's fees, costs, expenses, and interest pursuant to applicable law; and

k. An award to Otto of such other and further relief as the Court deems just and proper.

Respectfully Submitted,

Dated: January 3, 2022

By: s/ Jeffer Ali
Jeffer Ali (#247947)
Tye Biasco (#352600)
PATTERSON THUENTE PEDERSEN, P.A.
4800 IDS Center

80 S. 8th Street
Minneapolis, MN 55402-2100
Phone: 612-349-3004
Fax: 612-349-9266
ali@ptslaw.com
biasco@ptslaw.com

Attorneys for Plaintiff Michael James Otto